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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,548	04/07/2006	Shinsaku Fujimori	Furuya Case 1421	7461
23474 7590 10/17/2008 FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631				
EXAMINER SCHLENTZ, NATHAN W				
ART UNIT		PAPER NUMBER		
1616				
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10/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,548

Applicant(s)

FUJIMORI ET AL.

Examiner

Nathan W. Schlientz

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 5/18/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1-7 are pending. Claims 3-7 were amended in a preliminary amendment filed 18 May 2005. Claims 1-7 were examined herein on the merits for patentability. No claim is allowed at this time.

Information Disclosure Statement

The information disclosure statement (IDS) filed concurrently with the filing of the application has been fully considered, and a copy is attached herein with the examiner's statement of consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimori (Nogyo Gijutsu, 2001; document AQ in the IDS filed 5/18/05; English language translation referred to herein and attached).

Fujimori discloses light-burnt magnesite, "Magwhite", as a soil hardener for use as pavements of gardens, prevention of erosion of farm lands, soil layer improvements,

artificial stone materials, gardening supplies, piles, bricks, earth panels, earth floors, molded articles, panels, etc. (pg. 8, Table 1; pg. 15, ll. 5-9; pg. 18, ll. 1-5 and 21-23; pg. 19, ll. 1-8; pg. 20, ll. 10-24; and pg. 21, ll. 1-3). Fujimori further discloses that the Magwhite can have an effect as anti-weeding agent (i.e., suitable for inhibition of weed growth) (pg. 19, ll. 20-24; and pg. 20, ll. 1-5).

2. Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinsaku et al. (JP 2002-241154 A; document AP in the IDS filed 5/18/05; English language equivalent US 7,070,647 referred to herein).

Shinsaku et al. disclose a cement capable of solidifying a wide range of soil and applicable to a biological environment, wherein the cement comprises light burned magnesia, phosphate fertilizers, gypsum and water (Abstract). Shinsaku et al. disclose examples wherein the cement composition comprises about 13% light burned magnesium oxide, about 15% sand, about 36% soil and about 33% water, and the compositions are pushed into a mold (Examples 12-14). Shinsaku et al. disclose that the mold will not spoil scenery, such as unburned brick, artificial stone, soil concrete mold, permanent footpaths, week preventive footpaths, surface soil improvement, etc. (col. 7, ll. 56-67; and col. 8, ll. 1-28).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedges (US 5,105,577) in view of Shinsaku et al. (JP 2002-241154 A; document AP in the IDS filed 5/18/05; English language equivalent US 7,070,647 referred to herein).

Applicant claims:

Applicants claim a weed-controlling mulching composition comprising 3 to 30 wt.% magnesite cement and 97 to 30 wt.% water.

Determination of the scope and content of the prior art
(MPEP 2141.01)

Hedges teaches artificial mulch chips with a specific gravity greater than 1, wherein the mulching chips further comprise animal repellents, insecticides or odorants, and are embossed and colored to simulate bark chips from a tree (Abstract; and col. 3, ll. 35-38). Hedges teaches that the mulching chips conserve moisture and retard weed growth (col. 2, ll. 55), and include compounding ingredients useful for adjusting the specific gravity, or as fillers, such as magnesite (col. 3, ll. 4-8). Hedges teaches that it is

desired to impart a particular color to the mulching chips, wherein the colorants include both organic and inorganic pigments (col. 3, ll. 9-12). Also, Hedges teaches that the mulch chips may be formed from foamed plastics comprising all or part of recycled plastics from which the chips are made, wherein the foamed chips provides the advantage of requiring less plastic materials for a given chip volume (col. 4, ll. 33-38).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Hedges does not teach the mulch chips to comprise about 3 to 30 wt.% of magnesia and about 97 to 30 wt.% water, as instantly claimed. However, Shinsaku et al. teach lightly burned magnesia cement compositions which can be molded and are used for landscaping, such as artificial stone, soil concrete molds, footpaths, weed preventatives, etc., wherein the composition comprises about 13% light burned magnesium oxide, about 15% sand, about 36% soil and about 33% water (Examples 12-14).

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-43)

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time of the invention to formulate the mulch chips of Hedges for use as weed controlling ground cover, wherein the mulch chips comprise light burned magnesia and water, as reasonably taught by Shinsaku et al.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed

invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWS

/John Pak/
Primary Examiner, Art Unit 1616